Section III (Remarks)

A. Submission of Request for Continued Examination

A Request for Continued Examination Form PTO/SB/30 is submitted herewith to remove the finality of the rejections identified in the November 15, 2006 Office Action. Payment of the $790.00 fee applicable to a large entity pursuant to 37 CFR 1.17(e) for such Request for Continued Examination under 37 CFR 1.114 is authorized in the enclosed Credit Card Payment Form PTO-2038 (along with the above-identified Extension of Time fee).

B. Summary of Recent Prosecution Activity

In the present application, a Final Office Action was issued on November 15, 2006. Applicant submitted a Response to such Final Office Action on December 4, 2006. Applicant then filed a Supplemental Response to the Final Office Action on December 22, 2006, along with a (First) Declaration of Jeff Grady providing evidence of the non-obviousness of the claimed subject matter. A first Advisory Action was issued on January 11, 2007, indicating (1) that the amendments proposed by Applicant in the December 4, 2006 Response would NOT be entered because they purportedly raised the issue of new matter, and (2) that the (First) Declaration WOULD be entered into the application.

On February 12, 2007, Applicant filed a Response to the January 11 Advisory Action and further Response to the November 15, 2006 Final Office Action. A second Advisory Action was issued on March 19, 2007, indicating that most of the amendments proposed by Applicant in the February 12, 2007 Response would NOT be entered because (1) they raised new issues that would require further consideration and/or search; and (2) they purportedly raised the issue of new matter. The March 19, 2007 did indicate, however, that the drawings as filed on February 12, 2007 were acceptable. Applicant understands this to mean that such amended drawings have been entered into the application; however, if Applicant's understanding in this regard is incorrect, the Examiner is requested to advise Applicant of the true status of the requested drawing amendments.

Based on the foregoing, Applicant understands that none of the amendments to the claims or specification text, as requested on December 4, 2006 and February 12, 2007, have been entered into the application.

C. Summary of Current Amendments to the Application

Claims 10, 15, 17, 23, 30, 52, and 56 have been amended herewith. Claims 10, 23, and 56 have been amended to eliminate mention of an "IEEE 1394 compliant" coupling and to reflect that Firewire is a registered trademark. Claims 15 and 30 have been amended to reflect that iPOD is registered trademark. Claim 17 has been amended to correct typographical errors relating to the inadvertent omission of the article "a" and the connector "and." Claim 52 has been amended to recite that the FM receiver is "adapted to receive audio-containing radio signals from radio stations." Support is found in the original disclosure for the amendment to claim 52, for example, at page 4, first full paragraph, which states that the audio player preferably "comprises a FM receiver for receiving radio signals from adjacent radio states (*sic, stations*)... ."

In the specification, amendments have been made to portions of pages 4, 7, and 8. At page 4, in the first full paragraph, Applicant's use of the word "states" in the original text is an obvious typographical error, and has been corrected herewith without adding new matter pursuant to MPEP 2163.07.[1] At page 7, in the second paragraph, the text has been amended to conform to the drawings by indicating that the four speakers 14 [are] "associated with a body 11." At page 8, in the second pargraph, the text has further been amended to conform to the drawings by indicating that:

> Further provided are control elements 17A, 17B, of which one control element may be employed for frequency tuning control. A frequency indicator or display element 19 is further provided.

No new matter within the meaning of 35 U.S.C. 132(a) has been added by any of the foregoing amendments. The Examiner's "new matter" objections stated in the March 19, 2007 Advisory Action are addressed below.

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[1] See also *In re Odd*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971) (An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction).

D. Response to "New Matter" Objections in the March 19, 2007 Advisory Action

In the March 19, 2007 Advisory Action, the Examiner objected to the following amendment to the written description at the second paragraph of page 8: "further provided are control elements 17A, 17B of which one control element may be employed for frequency tuning control," as purportedly containing new matter. (The same amendment is requested herewith.) In support of the new matter objection pertaining to such amendment, the Examiner stated:

> The original specification does not disclose that one of the raised cylindrical knobs (now labeled 17A and 17B) is for frequency tuning control. In addition, the original specification discloses that the frequency tuning control element is located in the modular docking unit (see original claim 13). Since the raised cylindrical knobs (now labeled 17A and 17B) are located outside of the modular docking unit (see figure 1), they are clearly not for frequency tuning control.

March 19, 2007 Advisory Action, page 2.

The Examiner's conclusions in this regard are based on a myopic understanding of the present application, and lack legal basis or logical foundation, as detailed below.

1. The Examiner Has Impermissibly Ignored the Drawings as a Basis for Disclosure of a Frequency Tuning Control Element Disposed Outside the Modular Docking Unit

It is well settled that the specification of a patent application includes the drawings,[2] and that drawings may be relied upon to satisfy the disclosure requirements of 35 U.S.C. §112.[3] As noted by the predecessor court to the Federal Circuit, **whatever is disclosed by the drawings "may be added to the specification in words without violation of the statute and rule [35 U.S.C. 132,**

[2] See, e.g., *In re Hopkins*, 145 USPQ 140 (C.C.P.A. 1965)(Drawings are considered as part of patent disclosure). See also George Ticknor Curtis, Law of Patents for Useful Inventions 315-16 (4th Ed. 1873): "It has been settled, that the drawings constitute a part of the specification, when annexed thereto, and may be used to explain or help out the otherwise imperfect description in the specification. So that it is not necessary that the description should be wholly in writing, but it may be partly in writing and partly in drawing; and if by comparison of the words and the drawings, but one will explain the other sufficiently to enable a skillful mechanic to perform the work, and to show what is the invention claimed, the specification will be sufficient."

[3] *Ex parte Horton*, 226 USPQ 697, 699 (Bd. Pat. App. & Int. 1985), *citing*: *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (C.C.P.A. 1981); *Breen v. Cobb*, 487 F.2d 558, 179 USPQ 733 (C.C.P.A. 1973); *In re*

Rule 118] which prohibit new matter." *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537, 542 (C.C.P.A. 1962)[4]. The Federal Circuit recognizes that "under proper circumstances, "**drawings alone may provide a 'written description' of an invention** as required by § 112." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

In the present application, the written description makes clear that the claimed audio player may include a frequency tuning control element. See, for example, Application, page 4, second full paragraph (referring to "frequency tuning control") & page 11 (original claim 13), referring to "a frequency tuning control."

The Examiner does not dispute that the originally-filed drawings disclose "raised cylindrical knobs," which are now identified with element numbers 17A and 17B in the amended drawings. E.g., March 19, 2007 Advisory Action, page 2. Nor does the Examiner dispute that the raised cylindrical knobs as illustrated in the drawings "are located outside of the modular docking unit." Id.

The present application includes three drawing figures, each showing an audio player configured as a boombox, adapted to receive and operate with a portable digital media storage and playback device (e.g., an iPod® device). The audio player assembly depicted in each figure shows two raised cylindrical knobs placed prominently along the front of the unit within view and easy reach of the user. The size of each raised cylindrical knob is apparent by comparison to the iPod device illustrated as docked with the audio player assembly or boombox. The size, shape, and placement of each raised cylindrical knob are consistent with the use of such cylindrical knob as a control element to be grasped and operated by a user. These facts, along with the depiction of the raised cylindrical knobs outside of the modular docking unit, are apparent to the reader of the application. See, e.g., the enclosed "Second Declaration of Jeff Grady in Support of U.S. Patent

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Reynolds, 443 F.2d 384, 170 USPQ 94 (C.C.P.A. 1971); and *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962).

[4] See also *In re Heinle*, 145 USPQ 131, 136 (C.C.P.A. 1965)(Drawings and specification may be amended to conform to each other; added matter is not technical "new matter" within prohibition of 35 U.S.C. 132).

Application No. 10/780,329" (hereinafter, "Second Grady Decl."), ¶ 5. The Examiner is advised to give careful consideration to Mr. Grady's statements.[5]

Returning to the Examiner's misstatement that "[t]he original specification does not disclose that one of the raised cylindrical knobs is for frequency tuning control" (March 19, 2007 Advisory Action, page 2), it is clear that the Examiner has ignored the disclosure provided by the drawings, choosing to focus entirely on the specification text. As noted by Mr. Grady, the size, shape, and placement of the cylindrical knobs is consistent with their use as control elements, and the only control element disclosed in the original specification text is a "frequency tuning control." The Examiner's abject refusal to consider the drawings as a source of disclosure, especially taken together with the context of the original application text, reveals the erroneous character of the "new matter" objections. It is settled law that whatever is disclosed by the drawings may be added to the specification in words without violation of the statute and rule [35 U.S.C. 132, Rule 118] which prohibit new matter (*In re Wolfensberger, supra*). Such law cannot be simply ignored by the Examiner with regard to the present application.

2. One of Ordinary Skill in the Art Would Readily Comprehend That One of the Control Elements 17A, 17B Is For Frequency Tuning Control, and May Be Disposed Outside the Modular Docking Unit

For purposes of evaluating application sufficiency under Section 112, first paragraph, consideration of **what the drawings conveyed to persons of ordinary skill** is ***essential***. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111, 1119 (Fed. Cir. 1991) (emphasis added). It is not new matter to amend drawing and specification to make explicit a disclosure which was implicit in application as filed. *Tektronix, Inc. v. United States et al.*, 165 USPQ 392, 394 (Cl. Ct. 1970) (emphasis added).

Upon review of the entire original application, including specifically:

(1) the original drawings illustrating the two raised cylindrical knobs, consistent in size, shape, and position with control elements; and

(2) textual references to a "frequency tuning control,"[6]

[5] An affiant's opinion regarding whether a patent application provides adequate written description of the claimed invention should not be disregarded by the Examiner. *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1998)

one of ordinary skill in the art would understand that the raised cylindrical knobs represent control elements, of which one may be used for frequency tuning control. Second Grady Decl., ¶¶ 5-7. Furthermore, given the clear illustration in the figures of the cylindrical knobs / control elements as being located outside the modular docking unit, **one of ordinary skill in the art would further understand that the frequency tuning control element may be disposed outside of the modular docking unit**. Id. Accordingly, the disclosure of a frequency tuning control element disposed outside the modular docking unit is at least implicitly disclosed in the original application. Making express such disclosure does not constitute new matter. E.g., *Tektronix, supra.*

The foregoing understanding of one skilled in the art is further consistent with Applicant's intentions in submitting the Figures. The two raised cylindrical knobs depicted therein were specifically contemplated to be control elements, with one useable for frequency tuning control and the other useable for volume control, and with both disposed outside the modular docking unit. Second Grady Decl., ¶ 10.

In the present case, the Examiner has ignored what the drawings, together with the balance of the application, convey to one of ordinary skill in the art. This constitutes legal error. The Examiner's refusal to consider the drawings and the balance of the application as it would be perceived by one of ordinary skill in the art further betrays the erroneous nature of the "new matter" objections.

3. The Original Specification Does NOT Require The Frequency Tuning Control Element to Be Located In the Modular Docking Unit

As noted previously, the Examiner has stated:

> ... the original specification discloses that the frequency tuning control element **is** located in the modular docking unit (see original claim 13). Since the raised cylindrical knobs (now labeled 17A and 17B) are located outside of the modular docking unit (see figure 1), they are clearly not for frequency tuning control.

[6] See, for example, Application, page 4, second full paragraph (referring to "frequency tuning control") & page 11 (original claim 13), referring to "a frequency tuning control."

March 19, 2007 Advisory Action, page 2 (emphasis added).

The foregoing passage mischaracterizes the application; the Examiner should recognize that the original specification discloses that the frequency tuning control element **MAY BE** located (i.e., not "is" located) in the modular unit. See, for example, the following passage:

> Such modular docking unit **may** comprise various functional elements, including but not limited (a) means for retaining the MP3 player in position in the docking cavity; (2) coupling means for connection with an audio out port of the MP3 player, for receiving the audio signal therefrom; (3) amplifier for amplifying the received audio signal before such signal is outputted by the speaker; (4) power/charging circuitry for charging the MP3 player docked therein; (5) indicator lights for indicating the operational state of such unit (e.g., "charged" indicating that the unit is charging the battery of an MP3 player docketed therein); (6) **frequency tuning control** and/or frequency indicator, etc.

(Application, page 4, second full paragraph (emphasis added).) The Examiner is invited to recognize that the foregoing passage clearly provides that the modular docking unit "**MAY** comprise ... [a] frequency tuning control" – it does NOT state in any certain terms that such frequency tuning control is necessarily provided in the modular docking unit.

The Federal Circuit has recognized that the phrase "**may include**" relative to a particular feature in the written description of a patent application **does not mean that the invention "must include" that feature**. *Network LLC v. Centraal Corp.*, 58 USPQ2d 1076, 1083 (Fed. Cir. 2001).

With regard to the Examiner's citation to "original claim 13' in support of the premise that the frequency tuning control element "is located" (i.e., is *necessarily* located) in the modular docking unit, it is noted that claim 13 corresponded to one embodiment of the invention, and is not coextensive with the scope of the application disclosure. There exists no obligation – and indeed it would be impossible in most cases – for a patent applicant to claim an invention in precisely the same scope with which it is disclosed. In connection therewith, it is further noted that original claim 13 was a *dependent* claim, and under the doctrine of claim differentiation, an independent claim ordinarily should not be construed as containing a limitation that is explicitly

called out in one of its depending claims.[7] Thus, the fact that original claim 13 referred to a frequency tuning control located in the modular docking unit does NOT support the examiner's conclusion that that one of ordinary skill in the art would construe the original application as requiring that the frequency tuning control element be located in the modular docking unit – particularly in light of the drawings, which contradict this limited view of the application disclosure.

The Examiner has ignored that the term "may," within the context that a "modular docking unit may comprise ... [a] frequency tuning control," is an **optional** term. Based on the use of the phrase "may comprise" in this context – signifying "might comprise" or "could comprise" – one of ordinary skill in the art at the time the invention was made would understand that a frequency tuning control need not necessarily be incorporated into a modular docking unit. Second Grady Decl., ¶ 7. Such idea is reinforced by illustration of raised cylindrical knobs (which would be immediately recognizable by one skilled in the art as control elements) outside of the modular docking unit in each of drawing figures 1-3 as originally filed. Id. Thus, upon review of the original written description in combination with the originally-filed drawings, one of ordinary skill in the art at the time the invention as made would readily understand that control elements could be placed outside the modular docking unit. Id. That is, one of ordinary skill in the art at the time the invention was made would understand that original claim 13 discloses one possible location of the "frequency tuning control" (i.e., on the modular docking unit), and that the drawings disclose another possible location of a frequency tuning control (i.e., outside a modular docking unit). Second Grady Decl., ¶ 8.

At page 9, in the last full paragraph, the present application informs the reader of the following:

> While the invention has been described herein with respect to various illustrative aspects, features and embodiments, it will be recognized that the invention is not thus limited, but that the present invention extends to and encompasses other features, modifications, and alternative embodiments, as will readily suggest themselves to those of ordinary skill in the art based on the disclosure and illustrative teachings herein. The claims that follow are therefore to be construed and interpreted as including all such features, modifications and alternative embodiments, within their spirit and scope.

[7] See, e.g., *SunRace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1303, 67 USPQ2d 1438, 1442 (Fed. Cir. 2003); *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998); *In re Cruciferous Sprout Litigation*, 301 F.23d 1343, 1348-49, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002).

Such language thus alerts the reader to consider the specification expansively, without rigidly or unduly narrowing the scope of the invention to particular configurations described in connection with certain examples. The express contemplation of "other features, modifications, and alternative embodiments, as will readily suggest themselves to one of ordinary skill in the art," taken in conjunction with the drawings showing raised cylindrical knobs consistent with control elements disposed outside a modular docking unit, reinforces the fact that one skilled in the art at the time the invention was made would interpret the specification as disclosing a frequency tuning control disposed outside a modular docking unit. Second Grady Decl., ¶ 9.

The Federal Circuit has stated:

> **[T]he mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration.**[8]

The converse of this statement should also be true: that is, the mere fact that a patent claim is directed to a particular embodiment[9] should not operate to limit the drawings of the application to that specific configuration - particularly when the original drawings themselves provide contrary disclosure.[10]

Based on all of the foregoing evidence and arguments, withdrawal of the new matter objection (relating to the proposed amendment of the second paragraph of page 8) is warranted, and respectfully requested.

E. Response to Claim Rejections Under 35 U.S.C. 112

In the November 15, 2006 Office Action, claims 10, 23, and 56 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement since the original specification purportedly fails to disclose an IEEE 1394-compliant coupling.

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[8] *Anchor Wall Systems Inc. v. Rockwood Retaining Walls Inc.*, 67 USPQ2d 1865 (Fed. Cir. 2003), *citing Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956 [55 USPQ2d 1487] (Fed. Cir. 2000).

[9] E.g., original claim 13, directed to a frequency tuning control disposed a modular docking unit.

[10] I.e., of a control element – understood by one skilled in the art as a frequency tuning control element – clearly illustrated as disposed outside the modular docking unit.

Applicant disagrees with the 112 rejection in that Firewire® (as originally recited) is one example of an IEEE 1394-compliant coupling, but for the sake of avoiding further conflict and promoting rapid allowance of the application, claims 10, 23, and 56 have been amended to remove any recitation of an IEEE 1394-compliant coupling.

In view of these amendments, the claim rejections under 35 U.S.C. 112 should be withdrawn, and withdrawal of such rejections is respectfully requested.

F. Response to Claim Rejections Under 35 U.S.C. 103(a)

In the November 15, 2006 Office Action, claims 52-68 were rejected for obviousness on various prior art grounds, namely:

- Claims 52-60 and 62-68 were rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over U.S. Patent Application Publication No. 2004/0224638 to Fadell ("Fadell") in view of U.S. Patent Application Publication No. 2002/0002039 to Qureshey ("Qureshey"); and
- Claim 61 was rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over Fadell and Qureshey as applied to claim 52, and further in view of U.S. Patent Application Publication No. 2002/0086703 to Dimenstein ("Dimenstein").

Such rejections are traversed, as detailed below.

1. Law Regarding Obviousness Rejections

Concerning § 103 obviousness rejections, three requirements must be met for a *prima facie* case of obviousness. First the prior art reference(s) must teach all of the limitations of the claims. M.P.E.P. § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. M.P.E.P. § 2143.01. Third, a reasonable expectation of success is required. M.P.E.P. § 2143.02.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. It is insufficient to establish

obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. *Arkie Lures, Inc., v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). The fact that references could conceivably be modified or combined is insufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d1453 (Fed. Cir. 1998); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

A *prima facie* case of obviousness can be rebutted, *inter alia*, by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), *citing In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

2. Discussion of Fadell and Comparison to Claim 52

(a) **Fadell Clearly Teaches Wireless Transmission of Media Signals From a Portable MP3 Player to an External Media Device - NOT Reception by a Docking-Cavity-Containing Audio Player of "Radio Signals from Radio Stations"**

Fadell discloses various embodiments of a media player system that allow a portable digital media player (e.g., such as an Apple Computer iPod®) to communicate with other media devices. Fadell emphasizes over and over again that the purpose and thrust of the invention described therein is to **permit communication**, whether wired or wireless, **between a portable media player and other media devices**. See, e.g., the following passages from Fadell:

> [0007] The **invention relates**, in one embodiment, **to a docking station that allows a media player to communicate with other media devices**.
>
> [0008] The invention relates, in another embodiment, to a wireless media player system. The wireless media player system includes a hand held media player (e.g., music player) capable of transmitting information over a wireless connection. The wireless media player system also includes one or more media devices (e.g., tuning devices) capable of receiving information over the wireless connection.

[0009] The invention relates, in another embodiment, to a method of wirelessly connecting a hand held media player to another device. The method includes selecting a media item on the hand held media player. The method also includes selecting one or more remote recipients on the hand held media player. The method further includes transmitting the media item locally to the hand held media player, and wirelessly to the selected remote recipients.

[0010] The invention relates, in another embodiment, to a **hand held music player (e.g., MP3 player) that includes a transmitter** for transmitting information over a wireless connection. The **transmitter is configured to at least transmit a continuous music feed to one or more personal tuning devices that each include a receiver** capable of receiving information from the transmitter over the wireless connection.

[0041] The term **"media player" generally refers to computing devices that are dedicated to processing media such as audio, video or other images**, as for example, music players, game players, video players, video recorders, cameras, and the like. In some cases, the media players contain single functionality (e.g., a media player dedicated to playing music) and in other cases the media players contain multiple functionality (e.g., a media player that plays music, displays video, stores pictures and the like). In either case, **these devices are generally portable** so as to allow a user to listen to music, play games or video, record video or take pictures wherever the user travels.

[0055] In the illustrated embodiment, the media player includes a headphone jack 116 and a data port 118. ... The **data port 118 ... is capable of receiving a data plug/cable assembly configured for transmitting and receiving data to and from a host device** such as a general purpose computer (e.g., desktop computer, portable computer). By way of example, the **data port 118 may be used to upload or down load audio, video and other images to and from the media device 100**. For example, the data port may be used to download songs and play lists, audio books, ebooks, photos, and the like into the storage mechanism of the media player.

[0056] The data port 118 may be widely varied. For example, the data port may be a PS/2 port, a serial port, a parallel port, network interface port, a USB port, a Firewire port and/or the like. In some cases, **the data port 118 may be a wireless link** such as a radio frequency (RF) link or an optical infrared (IR) link in order to eliminate the need for a cable. ... .

[0058] FIG. 2 is a diagram of a media player system 150, in accordance with one embodiment of the present invention. The **media player system comprises a media player 152 and one or more media devices 154 that are connected via a media link 156. ... Media devices 154 are similar to the media player 152 in that they process media such as audio, video or other images**. The media devices may be widely varied. By way of example, the media devices may correspond to other media players, desktop computers, notebook computers, personal digital assistants, video or imaging equipment (e.g., cameras, monitors),

audio equipment (home stereos, car stereos, boom boxes), family radios (e.g., walkie talkies), peripheral devices (e.g., keyboards, mice, displays, printers, scanners), personal media devices (discussed in greater detail below) and the like.

[0059] The **media devices 154 and the media player 152 are configured to communicate with one another through media link 156**

[0060] The **media link 156 may be wired and/or wireless.** For example, the media link 156 may be made through connectors and ports or through receivers, transmitters and/or transceivers. The media link may also be one way or two way. For example, in the case of one way, the media player may be configured to transmit signals to the media device but not to receive information from the media device (or vice versa) or in the case of two way, both the media player and media device may be enabled to receive and transmit signals therebetween. The signals may be data (analog, digital), power (AC, DC), and/or the like. In most cases, the data corresponds to data associated with the media player as for example audio, video, images and the like.

[0063] In wireless connections, the media terminals 158 do not physically connect. For example, **the media player 152 and the media device 154 may include a receiver and transmitter for wireless communications therebetween**. By way of example, the connection interface may include one or more of the following interfaces: FM, RF, Bluetooth, 802.11 UWB (ultra wide band), IR, magnetic link (induction) and/or the like.

[0096] FIG. 15 is a diagram of a wireless communication system 400, in accordance with one embodiment of the present invention. The **wireless communication system 400 generally includes a media player 402 and one or more media devices 404.** The media player 402 is configured to send media via a wireless communication link 406 to the media devices 404 and the media devices 404 are configured to receive the media sent by the media player 402 over the wireless communication link 406. The media player is essentially configured to act as a personal transmitting station so that the user can transmit media stored on the media player to other devices. In some cases, the media devices 404 may also send media to the media player 402 and the media player 402 may also receive media from the media devices 404. By way of example, the media may generally correspond to audio, video, images, text and the like.

[0097] **In order to send and receive media, the players and devices 402 and 404 generally include a transmitter, a receiver or a transceiver as well as some sort of antenna**. The media is generally sent via the transmitter and the media is generally received via the receiver. In one embodiment, the media player includes a transmitter while the media devices include a receiver (for one way communications). In another embodiment, both devices include a transceiver (for two way communications). The antenna may be fully contained within the players/devices 402 and 404 or they may extend outside the devices (as shown). By way of example, the wireless communication link may

> correspond to FM, RF, Bluetooth, 802.11, UWB (ultra wide band), IR (infrared), magnetic link (induction) and/or the like.
>
> [0103] FIG. 16 is a block diagram of a wireless communication system 420, in accordance with one embodiment of the present invention. The **system 420 generally includes a media player 422 and a media device 424 that connect via a wireless communication link 426.** Both the media player 422 and the media device 424 may be widely varied. For ease of discussion, **the media device 424 corresponds to a second media player that is similar to the first media player**
>
> [0108] The communication terminal 436 controls interactions with one or more media devices 424 that can be coupled to the media player 422 through a wireless link. The communication terminal 436 may include a transmitter, receiver or transceiver. In one embodiment, the first media player 422 includes a transmitter and the second media player 424 includes a receiver thereby providing one way communication therebetween. In the illustrated embodiment, **the first media player 422 includes a first transceiver and the second media player includes a second transceiver 424 for two way communication therebetween. The transmitter is configured to transmit information over the wireless communication link and the receiver is configured to receive information over the wireless communication link while the transceiver is configured to both transmit and receive information over the wireless communication link.**

(Emphasis added.)

Nothing in Fadell discloses or suggests that a media device should be used for "**receiv[ing] audio-containing radio signals from radio stations**" as required by amended claim 52 (and disclosed at page 6, fourth paragraph[11] of Applicant's specification) `````. Rather, each wireless receiver described in the various embodiments of Fadell is intended to receive communication signals from another portable media player.

With the entire thrust and purpose of Fadell being to **allow a portable media player to communicate with other portable media playing devices**, any radio receiver provided in such a device according to Fadell is *not* used to receive radio signals from radio stations. Moreover, there exists no suggestion or motivation to modify Fadell to provide an FM receiver adapted to receive audio-containing radio signals from radio stations. Since Fadell concerns wireless

[11] *"Preferably, such audio player ... comprises an **FM receiver coupled with the speakers for receiving radio signals from near-by radio stations**."*

transmission between portable devices with low transmission power capability commensurate with their battery powered nature, **it would frustrate the purpose of Fadell's espoused invention to apply the same receiver used for inter-device communication to *further* receive high-powered radio signals from radio stations**, since such high-powered radio station signals of similar frequency would **interfere** with reception of low-powered inter-device signals. It is well settled that a proposed modification that would render the prior art invention unsatisfactory for its intended purpose cannot support a suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Since Fadell fails to teach any FM receiver adapted to receive audio-containing radio signals from radio stations, and there exists no motivation to modify Fadell to include such an FM receiver, no *prima facie* case of obviousness premised on Fadell can be established pursuant to MPEP §§ 2143.01 & 2143.03.

(b) **A Boom Box Adapted to Receive an MP3 Player Need Not – and Often Does Not – Contain a Radio**

In the January 11, 2007 Advisory Action at page 3, the Examiner stated:

> Applicant further argues that the sound system (or media device) 370 in figure 12 [of Fadell] does not have a radio receiver as claimed. The examiner, however, disagrees. Applicant's attention is directed to Fadell, paragraph [0058] which discloses that the media devices 154 comprises audio equipments such as **boom boxes**. **Such boom boxes clearly comprises (sic) AM/FM radio receiver**. ... Accordingly, the audio system 370 in figure 12 does comprise a FM receiver as claimed. (Emphasis added.)

Applicant takes issue with the Examiner's statement – unsupported by any evidence whatsoever - that the "boom box" mentioned by Fadell "clearly comprises [an] AM/FM radio receiver," for at least the reasons stated below.

(1) ***Dictionary and Encyclopedia Entries Describe Boomboxes Without Radios***

Several prominent online dictionaries including "WordReference.com" and "WordWebOnline.com," define a "boom box" simply as "a **portable stereo**" – a definition that ***omits any requirement that a radio be included***. See, e.g.:
http://www.wordwebonline.com/en/BOOMBOX; and
http://www.wordreference.com/definition/boom%20box

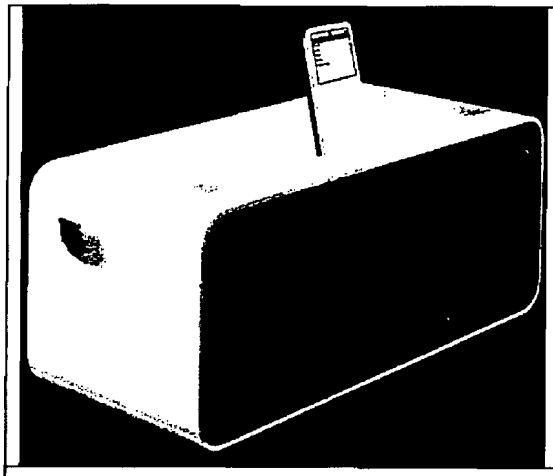
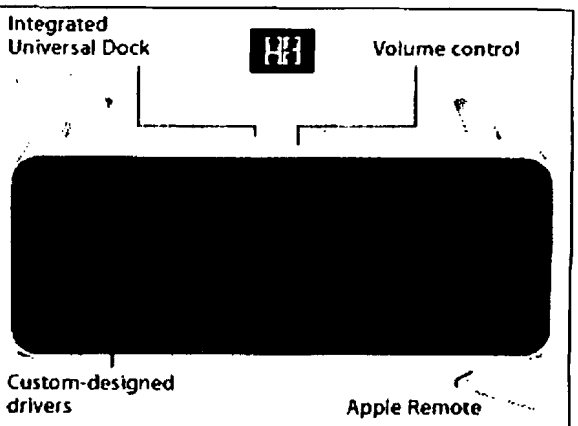
Online encyclopedias – expected to provide greater detail than dictionaries – are not inconsistent with the foregoing definitions. One highly respected online encyclopedia, www.channelweb.com, provides a highly detailed definition of a "boom box" that ***omits the term "radio" entirely***, with such definition being reproduced below:

> **Results found for: boom box**
>
> **A self-contained stereo system for playing music. Available in a myriad of styles, a boom box contains an amplifier, speakers and CD and/or tape cassette drives.** The CD system plays standard CD-DA music tracks and may also play MP3 and other compressed audio formats. Some units accept memory cards for MP3 files. The equivalent of the "portable record player" of the 1960s, boom boxes are either small, battery-operated portables, or they are large, transportable units that require AC power. Battery-driven boxes typically have an AC power option.

Source: http://www.channelweb.com/encyclopedia/defineterm.jhtml?term=boom+box

(2) ***Apple Computer – the Assignee of Fadell – Produces and Sells the "iPod HiFi" Boombox, Which Closely Corresponds to the Fadell's Sound System 370" and Lacks a Radio***

Fadell clearly identifies on its cover page that the assignee of Fadell's U.S. Patent Application No. 10/423,490 is "Apple Computer, Inc." Apple Computer is the manufacturer of the popular iPod media player capable of playing and storing MP3 audio files. In early 2006 – just over a year after Fadell was published – Apple Computer launched an iPod-compatible portable boombox called the "iPod HiFi." Two pictures of the product are provided below:

	
Source: http://www.apple.com/ipodhifi/design.html	Source: http://www.gearlive.com/index.php/news/article/the-ipod-hifi-boombox-02281041/

Apple Computer's launch of the iPod HiFi boombox product was widely covered by the media. The headlines for several examples of online stories discussing the iPod HiFi boombox, and URL links to such stories, are reproduced below.

1. The iPod Hi-Fi Boombox

February 28, 2006 at 12:00 PM
http://www.gearlive.com/index.php/news/article/the-ipod-hifi-boombox-02281041/

2. Apple announces iPod Hi-Fi boombox

Tuesday, February 28, 2006
http://www.appleinsider.com/article.php?id=1561

3. Apple powers up iPod Hi-Fi boombox

01 Mar 2006
http://www.itweek.co.uk/vnunet/news/2151127/apple-unveils-ipod-boombox

4. Apple announces new... iPod Hi-Fi Boombox

Tuesday, February 28th, 2006
http://www.macenstein.com/default/archives/246

5. Apple's New Boombastic Boom Box the iPod Hi-Fi

THURSDAY, MARCH 2, 2006
http://www.macidol.com/reviews/ipod/accessories/

6. Apple Unveils iPod 'Hi-Fi' Boombox

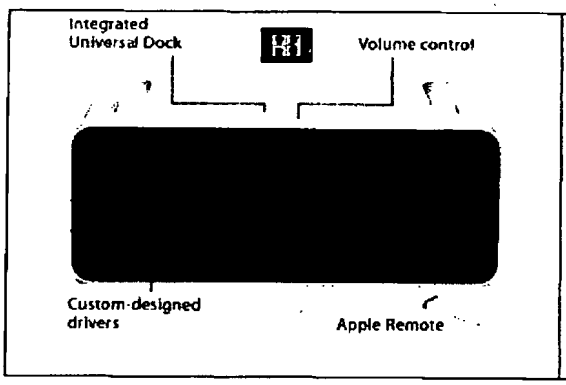
February 28, 2006, 1:40 PM
http://www.betanews.com/article/Apple_Unveils_iPod_HiFi_Boombox/1141152053

7. Apple launches iPod 'Hi-Fi' Boombox

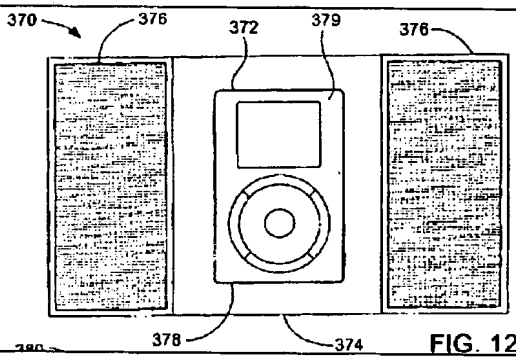
Wednesday, March 1st, 2006
http://www.techshout.com/gadgets/2006/01/apple-launches-ipod-hi-fi-boombox/

While it is unmistakably clear from the foregoing headlines and related stores that Apple's iPod HiFi is understood to be a "**boom box**," **multiple sources confirm that the iPod HiFi Boombox LACKS ANY RADIO whatsoever**.[12]

The close correspondence in structure and function between Apple's HiFi Boombox and the "sound system 370" of Fadell is likewise clear.



[12] *See, e.g.*, http://www.gearlive.com/index.php/news/article/the-ipod-hifi-boombox-02281041/ ("*The biggest of the "fun new" Apple products of the day turns out to be the iPod HiFi Boombox. ... The iPod Hi-Fi can be controlled with the Apple Remote, which comes bundled with the unit. It can also accept audio input through an auxiliary jack and SPDIF optical audio input, which means it can be used with non-iPod audio players.* ***Our only concern is the lack of an FM tuner.***"); andhttp://washingtontimes.com/technology/20060320-093055-6260r.htm ("*Apple Computer's IPod Hi-Fi is a $349 "boom box" of a stereo that may leave some folks scratching their heads. ... although some* ***critics have bemoaned the lack of a built-in radio tuner****, there's more than one way to compensate, it turns out. ... Check out the back of the IPod Hi-Fi and you'll see a "line in" jack that would handle your typical audio cable. But it also is equipped to handle digital audio cables.*")

	 FIG. 12
Annotated Photograph of Apple's iPod HiFi Boombox (see gearlive.com Headline 1, above) "Its clean, all-in-one design features a unique isolated **enclosure system that includes two custom designed wide-range speakers** ... . iPod Hi-Fi features handles to easily transport your stereo anywhere, a removable front grille with precision-mounting clips, touch-sensitive **volume control buttons**, the Apple Remote for easy **song and volume control** from anywhere in the room, a universal power supply incorporated into the all-in-one design ... and the ability to power iPod Hi-Fi from six D-cell batteries for true portability. ... [f]eaturing seamless integration with all iPods with a **dock connector** ... ." Text source: http://www.apple.com/pr/library/2006/feb/28hifi.html	Fadell FIG. 12, described in paragraph [0091] as follows: "FIG. 12 is front view of a **sound system 370 with an integrated docking station 372**, in accordance with one embodiment of the present invention. The sound system may be widely varied. For example, it may be a substantially fixed or portable unit. In the illustrated embodiment, **the sound system 370 is a flat panel unit that includes a base 374 and a pair of speakers 376**. ... The docking station 372 is integrated within the base 374. The docking station 372 includes a media bay 378 that may be placed anywhere on the base 374, as for example, the sides, top, front, back or bottom surfaces. The media bay 378 may be configured to receive any surface of a media player 379 ... . Fadell, paragraph [0091].

From the items identified in the preceding table, consider the correspondence between features of the Apple iPod HiFi boombox and the "sound system 370" of Fadell, as identified below:

Apple HiFi Boombox	**Fadell's "Sound System 370"**
"enclosure system"	"sound system ... that includes a base 374"
"two ... wide-range speakers'	"pair of speakers 376"
"dock connector" on top of unit to receive iPod	"docking station 372 includes a media bay 378 that may be placed .... [on] the top surface ...

	to receive ... media player 379"
"six D-cell batteries for true portability"	"may be a ... portable unit"
no mention of any radio	no mention of any radio
no mention of any FM receiver adapted to receive radio signals from radio stations	no mention of any FM receiver adapted to receive radio signals from radio stations
no illustration or mention of any radio frequency indicator or frequency tuning control	no illustration or mention of any radio frequency indicator or frequency tuning control

(3) Numerous Other Manufacturers Sell MP3 Docking Portable Amplified Speaker-Containing Devices Lacking Radios and Termed "Boomboxes"

It is no fluke that Apple's iPod HiFi lacks a radio but is still called a boombox, since numerous other manufacturers also sell as "boomboxes" portable amplified speaker-containing devices useful for docking MP3 players but lacking radios. See, e.g., **Harman Kardon "Go + Play iPod docking boombox"** described at http://www.pcmag.com/article2/0,1895,2015354,00.asp with a headline of "*A Futuristic and Advanced iPod Boombox;*" and **MTX iThunder** "*the portable boom box music sharing system for your iPod*" illustrated and described at http://www.mtx.com/ithunder/. Both of these boombox products are currently offered for sale, and **neither contains any radio**.

(c) The Examiner's Rejection Premised Solely on "Common Knowledge" is Legally Insupportable Under MPEP 2144.03

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. MPEP 2144.03. As noted by the predecessor court to the Federal Circuit in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner **must be "capable of such instant and unquestionable demonstration as to defy dispute"** (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961). It is **never appropriate to rely solely on common knowledge in the art without evidentiary support in the record** as the principal evidence upon which a rejection was based. See *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ 421; MPEP 2144.03.

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

Applicant has provided herewith substantial evidence demonstrating that portable amplified speaker systems for use with MP3 players and lacking radio receivers are widely recognized as being "boom boxes." **It is particularly compelling that Apple Computer** – the very same assignee named on the cover page of Fadell – **sells a portable boombox product** (i.e., the "iPod HiFi") **that lacks a radio** ***and conforms almost exactly in character to the "sound system 370"*** disclosed by Fadell. **Such evidence clearly refutes the Examiner's unsupported theory that a 'FM receiver adapted to receive audio-containing radio signals' is clearly disclosed as present in the "sound system 370" of Fadell**.

To the extent that the Examiner is tempted to maintain his position (i.e., that Fadell discloses a radio in the sound system 370) such rejection in the face of such clear evidence to the contrary, **Applicant hereby challenges the Examiner, pursuant to MPEP 2144.03, to provide an affidavit or declaration setting forth specific factual statements and explanation to support his factual finding as "instant[ly] and unquestionabl[y] demonstrate[ed]."** *Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420. If the examiner is unable to do so, the 103(a) rejections must be withdrawn pursuant to MPEP 2144.03.

3. Discussion of Qureshey and Lack of Motivation to Combine with Fadell

Qureshey discloses a network-enabled audio device consistent with conventional stereo receivers, except for the addition of certain network capabilities. No docking cavity is disclosed. The Examiner relies upon Quereshey because it teaches a frequency tuning control and a frequency indicator on a main body portion. Advisory Action, page 4. Applicant does not

dispute the disclosure of Qureshey in this regard. What Applicant does dispute is any motivation to combine Qureshey with Fadell.

As indicated previously, Fadell does teach a "sound system 370" having a docking cavity and at least one speaker, but Fadell fails to teach any FM receiver adapted to receive audio-containing radio signals from radio stations, or in association therewith a frequency indicator disposed on the main body portion and a frequency tuning control disposed on the main body portion.

In the November 15, 2006 Office Action, the Examiner stated:

> [I]t would have been obvious to one of ordinary skill in the art at the time of the invention to provide (sic – *apply*) the ... teaching of Qureshey [namely, any audio player having a main body portion comprising a frequency indicator and frequency tuning control] to Fadell, in order to allow the user to easily visualize which channel the FM receiver is tuned to.

Since Fadell fails to teach or suggest any FM receiver adapted to receive audio-containing radio signals from radio stations, there exists no reason to add a frequency indicator and frequency tuning control to allow the user to easily visualize the channel to which such FM receiver is tuned. This is consistent with the lack of any frequency indicator or frequency tuning control illustrated or described in connection with the sound system 370 of Fadell FIG. 12, and with the lack of any frequency indicator or frequency tuning control (or FM receiver) in the Apple iPod HiFi boombox corresponding so closely to Fadell's sound system 370.

Since there exists no motivation to combine the radio-related features of Qureshey's conventional stereo receiver with Fadell's sound system 370 adapted for inter-portable-device communication, no *prima facie* case of obviousness has been established as to amended claim 52. Accordingly, withdrawal of the § 103 rejection of claim 52 – and of all claims depending therefrom – is respectfully requested.

4. Objective (Secondary) Evidence Supports Applicant's Contention That the Claims Are Not Obvious Over the Cited Art

(a) **Law Regarding Objective Evidence or 'Secondary Considerations' of Non-Obviousness**

Applicant previously submitted the Declaration of Jeff Grady In Support of U.S. Patent Application No. 10/780,329 on December 22, 2006 (hereinafter, "First Grady Decl.") Such document is understood to be of record in the instant application as indicated in the January 11, 2007 Advisory Action.

Objective evidence (also termed "secondary considerations") of nonobviousness may relate to any of the factors identified in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) including **commercial success**[13], fulfilling a long felt need, failure of others, **copying by others**, or unexpected results. (Emphasis added.) In addition, Federal Circuit case law provides that secondary considerations may include **success of a potentially infringing product**, *i.e.*, a product manufactured by a third party[14].

"**[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record**. It may often establish that an invention appearing to have been obvious in light of the prior art was not." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983).

It is well settled that evidence of nonobviousness, if presented, cannot be ignored:

> In an appeal of a rejection patent application, secondary considerations, such as commercial success, typically do not play a large part in the analysis of obviousness because the inventor usually waits until his patent issues before he swings production into full gear. ... If, however, a patent applicant properly presents evidence relating to these secondary considerations, the Board [of Patent Appeals and Interferences] ***must always* consider such evidence in connection with the determination of obviousness.**

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[13] *See also In re Huang*, 100 F.3d 135, 139-40; 40 USPQ2d 1451, 1454 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1685, 1689-90 (Fed. Cir. 1996).

[14] *See Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 56 USPQ2d 1456, 1464 (Fed. Cir. 2000) (evidence of infringing product in patent infringement action considered in secondary considerations).

In re Sernaker, 702 F.2d 989, 217 USPQ2d 1, 7 (Fed. Cir. 1983) (*quoting In re Fielder*, 471 F.2d 640, 644, 176 USPQ 300, 303 (C.C.P.A. 1973). *See also* MPEP 214, which states:

> **Objective evidence or secondary considerations** such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts **are relevant to the issue of obviousness and must be considered in every case in which they are present.** When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence.

(b) Discussion of Secondary Considerations Evidence

(1) Commercial Success of Applicant's IBOOM® Boombox Product

Applicant is the President and Chief Executive Officer of Netalog, Inc., a company that manufactures and sells the IBOOM® boombox. First Grady Decl., ¶¶ 1, 3. The IBOOM® boombox is an audio player that includes (1) a main body portion with a docking cavity for docking a MP3 player or portable digital media player; (2) multiple speakers; (3) a radio receiver; and (4) a frequency tuning control and a frequency indicator on the main body portion. First Grady Decl., ¶¶ 2-3. In this regard, Netalog's IBOOM® boombox closely corresponds to and embodies the subject matter of most, if not all, of the pending claims of U.S. Patent Application No. 10/780,329. Id.

Netalog's IBOOM® boombox was introduced in 2004. First Grady Decl. ¶ 3. Within the past two years, Netalog has sold more than 85,000 examples of its IBOOM® boombox. First Grady Decl. ¶ 4. Based on Netalog's understanding of the retail prices at which IBOOM® boombox have been sold, it is believed that the aggregate revenue generated by sales of IBOOM® boomboxes has exceeded $8.5 million. First Grady Decl. ¶ 4. While such sales and revenue are impressive in their own right, it is important to note that a vast number of third party products (*i.e.*, **at least nineteen (19) products**) reading on at least some of the claims of the present application and competing directly with the IBOOM® boombox have been introduced to the market at times believed to be *after* Netalog's introduction of the IBOOM® boombox (First Grady Decl. ¶¶ 6-26 & Exhibits B-U). It should be presumed that commercial success of Netalog's IBOOM® boombox would have been much greater in the absence of such competing products.

In the January 11, 2007 Office Action, the Examiner dismissed as unpersuasive the foregoing evidence of commercial success, stating that "gross sales figures do not show commercial success absent evidence as to market share, or the time period during which the product was sold, or the normally expected sales in the market." January 11, 2007 Advisory Action, page 8. The Examiner has improperly ignored evidence of at least two of these factors presented in the (First) Declaration of Jeff Grady. Referring in particular to First Grady Decl., ¶ 4, Mr. Grady states that Netalog sold more than 85,000 units of the IBOOM boombox **within two years**. This provides ample evidence of the "time period during which the product was sold."

Furthermore, Mr. Grady's statement that he was unaware of any other product embodying the features of the pending patent claims at the time the IBOOM® boombox was introduced provides evidence that, as of its introduction, **the IBOOM® product had a 100% market share for products within the scope of the present patent claims at the time the IBOOM® boombox was introduced**. Mr. Grady has further provided evidence that, since the introduction of the IBOOM® boombox, at least **nineteen (19) other products embodying the inventive features now claimed** have been introduced to the market. It should be presumed that commercial success of the IBOOM® boombox would have been much greater in the absence of such competing products.

(2) Copying by Others of Applicant's IBOOM® Boombox Product

As noted previously, **at least nineteen (19) products** reading on at least some of the claims of the present application have been introduced by third parties, with such third party product introductions believed by Applicant to post-date Applicant's filing of the present application and Applicant's public release of the IBOOM® boombox. First Grady Decl. ¶¶ 6-26 & Exhibits B-U.

While Applicant has no *direct* evidence (e.g., testimony or other admissions) that third parties have copied Applicant's IBOOM® boombox, the following items support an inference that copying has taken place: (1) timing of the third party product releases well after Netalog's public disclosure of the claimed subject matter embodied in the IBOOM® boombox; (2) close correspondence between the essential features of the nineteen third party products and the

subject matter as currently claimed in the present application and Netalog's IBOOM® boombox; and (3) the huge number of competing products on the market - which suggests it is unlikely that so many would-be 'inventors' independently developed around the same time the very same combination of features embodied in the IBOOM® boombox and claimed in the current application.

(3) Commercial Success By Third Parties

Applicant does not have access to sales figures for third party products reading on at least some of the claims of the present application. The sheer number of competing products (i.e., at least nineteen (19) products), however, supports an inference that such third party products are commercially successful; otherwise, so many different products could not coexist in the market and so many different manufacturers would not undertake the risk of selling such products in a competitive marketplace. The Examiner is reminded that commercial success of potentially infringing third party products is properly considered as a secondary consideration of non-obviousness.[15] In this instance, the third party commercial success in selling products highly similar to Netalog's IBOOM® boombox – *after* Applicant invented the subject matter claimed in the present application – evidences the non-obviousness of Applicant's invention. If the invention were in fact obvious at the time the present application was filed, then the profit motive would have been a powerful incentive for third parties to have beaten Applicant to the punch in commercializing products embodying the invention. Such third party commercialization did not occur until **after** Applicant's invention of the subject matter now claimed.

In the January 11, 2007 Office Action, the Examiner dismissed as unpersuasive the (First) Grady Declaration. In this regard, the Examiner has wholly failed to address the presence of the overwhelming evidence of success of potentially infringing third party products. Federal Circuit case law provides that secondary considerations may include **success of a potentially infringing product**, *i.e.*, a product manufactured by a third party[16]. Applicant has identified nineteen (19) other products introduced to the market after the filing of the present patent application and after introduction of the IBOOM® boombox to the market. (See Grady Declaration.) While Applicant

[15] E.g., *Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 56 USPQ2d 1456, 1464 (Fed. Cir. 2000)

does not have access to sales figures or market share for such third party products, **the fact that so many products embodying the same features (*i.e.*, features within the scope of the present patent claims) have been introduced very close in time to one another provides an irrefutable inference of substantial third party commercial success.** Otherwise, so many different products could not coexist in the market and so many different manufacturers would not undertake the risk of selling such products in a competitive marketplace

In this instance, the third party commercial success in selling products highly similar to Netalog's IBOOM® boombox – *after* Applicant invented the subject matter claimed in the present application – evidences the non-obviousness of Applicant's invention. If the invention were in fact obvious at the time the present application was filed, then the profit motive would have been a powerful incentive for third parties to have beaten Applicant to the punch in commercializing products embodying the invention. Such third party commercialization did not occur until **after** Applicant's invention of the subject matter now claimed. The evidence of record attesting to these facts is uncontroverted.

Any suggestion that the subject matter claimed in the present application was obvious at the time of Applicant's invention is false, and can only be supported by hindsight knowledge of Applicant's invention. The Federal Circuit has repeatedly pronounced that **it is impermissible to use hindsight knowledge to reconstruct a patent claim in support of an obviousness rejection** thereof. *See, e.g., W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")

Accordingly, the Examiner is requested to properly consider all of the pertinent objective evidence of the non-obviousness of the invention as presently claimed, and withdraw the obviousness rejections under 35 USC § 103.

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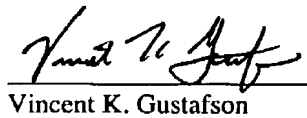
[16] *See Brown & Williamson Tobacco, supra* (evidence of infringing product in patent infringement action considered in secondary considerations).

CONCLUSION

Based on the foregoing, all of applicants' pending claims 1, 3-6, 9-11, 14-24, 27, and 30-68 are patently distinguished over the art, and in form and condition for allowance. The examiner is requested to favorably consider the foregoing, and to responsively issue a Notice of Allowance. If any issues require further resolution, the examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same.

Respectfully submitted,



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Enclosures:
Request for Continued Examination Form PTO/SB/30 [1 pg]
Second Declaration of Jeff Grady [9 pgs]
Credit Card Payment Form PTO-2038 Authorizing $1,810.00 [1 pg]

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